REMARKS

The above-referenced application was filed as a Request for Continued Examination (RCE) on January 26, 2004 to have the Amendment After Final filed on December 9, 2003 entered and fully considered. In the outstanding office action, claims 1 and 4-10 were rejected as obvious over a new reference, namely Shiffler, et al., U.S. Patent No. 6,564,942, in further view of the previously cited Hurh reference, U.S. Patent No. 4,998,656. However, Applicants respectfully submit that the Shiffler, et al. reference does not serve as a proper basis for an obviousness rejection, and thus request that the obviousness rejection of the pending claims be withdrawn.

More specifically, 35 U.S.C. §103(c), states that:

> "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), (g), of §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Here, Applicants respectfully submit that 35 U.S.C. §103(c), applies. Namely, the Shiffler, et al. reference only qualifies under Section (e) of 35 U.S.C. §102 as prior art, and at the time the present invention was made, it, as well as the Shiffler, et al. reference, were subject to an obligation of assignment to the same person, namely, S.C. Johnson Home Storage, Inc. Accordingly, the Shiffler, et al. reference does not qualify as prior art, and the rejection of the claims based thereon should be withdrawn.

With regard to the section of 102 under which Shiffler, et al. qualifies as prior art, 35 U.S.C. §102(a) requires, in pertinent part, that: "A person shall be entitled to a patent unless the invention was . . . patented . . . in this or a foreign country, before the invention thereof by the applicant for patent." This does not apply with respect to Shiffler, et al. Shiffler, et al. was not patented until May 20, 2003, a date clearly after the filing date of the present application, i.e. November 16, 2001, or in the wording of 35 U.S.C. §102(a), after the "invention thereof by the applicant for patent." Accordingly, Section (a) of 35 U.S.C. §102 does not apply with respect to Shiffler, et al.

Turning to 35 U.S.C. §102(b), again Shiffler, et al. does not qualify. It states, in pertinent part, that: "a person shall be entitled to a patent unless the invention was patented or described in a printed publication in this . . . country . . . more than one year prior to the date of the application for patent in the United States." Clearly, as Shiffler, et al. was not patented before the invention thereof by the present application as shown above with respect to §102(a), it was not patented more than one year prior to that date. Accordingly, Section (b) also does not apply.

With respect to 35 U.S.C. §102(c), it also does not apply as it requires that "a person shall be entitled to a patent unless he has abandoned the invention." Clearly, this has not happened and thus Section (c) of 35 U.S.C. §102 does not apply with respect to Shiffler, et al.

Finally, with respect to Section (d) of 35 U.S.C. §102, again, the Shiffler, et al. reference does not qualify. It requires, in pertinent part, that: "a person shall be entitled to a patent unless the invention was first patented . . . by the applicant . . . in a foreign country prior to the date of the application for a patent in this country on an application for patent . . . filed more than twelve months before the filing of the application in the United States." As no foreign patents were issued with respect to Shiffler, et al. prior to the filing of the present application, clearly §102(d) does not apply as well.

To the contrary, the only section of 35 U.S.C. §102 under which Shiffler, et al. qualifies as prior art is Section (e). It states: "a person shall be entitled to a patent unless the invention was described in . . . an application for patent . . . by another filed in the United States before the invention by the applicant for patent or a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." This does apply, and is the only section of 35 U.S.C. §102 under which Shiffler, et al. qualifies as prior art. More specifically, Shiffler, et al. is a patent granted on an application for patent by another filed in the United States (i.e., on November 13, 2000), before the invention by the Applicant for patent (i.e., on November 16, 2001). Accordingly, Shiffler, et al. only qualifies as prior art under 35 U.S.C. §102(e).

Having established the section of 35 U.S.C. §102 under which Shiffler, et al. qualifies as prior art, we return again to 35 U.S.C. §103 (c). Its second provision requires that the cited art and the pending application be subject to an obligation of assignment to the same person. This requirement is met as well. Both Shiffler, et al. and the present application are assigned to S.C. Johnson Home Storage, Inc., as evidenced by the assignments recorded in the U.S. Patent and Trademark Office.

Accordingly, 35 U.S.C. §103(c) fully applies, and the Shiffler, et al. reference cannot be used as part of the obviousness rejection. The rejection of claims 1 and 4-10, over Shiffler, et al., in view of Hurh, should therefore be withdrawn.

In light of all the foregoing, Applicants respectfully submit that each of the pending claims, i.e. claims 1 and 4-10, are in condition for allowance and respectfully request same. Should the Examiner have any questions, he is respectfully invited to telephone the undersigned.

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Respectfully submitted,

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